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10/757,152

01/14/2004

Marcus L. Thuesen

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10/15/2008

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EXAMINER

STIBLEY, MICHAEL R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/757,152 | Applicant(s) THUESEN ET AL. | |
| | Examiner MICHAEL R. STIBLEY | Art Unit 3688 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 and 43-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 and 43-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/14/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1 In response to Applicant's amendments and remarks regarding the Restriction Requirement of 5/28/2008, Examiner withdraws said Restriction Requirement. A Detailed Office Action follows:

DETAILED ACTION

2 This Office Action is in response to the application filed originally on 1/14/2004 and as amended on 6/25/2008.

CLAIM STATUS

3 Claims 1-39 and 43-49 are currently pending in the instant application and have been examined. Claims 40-42 were cancelled by Applicant on 6/25/2008.

Double Patenting

4 The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, and 33 of the instant Application Serial No. 10/757152 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3, of U.S Patent 7,264,582 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: both the instant application's claims and the claims of US Patent 7,264,582 B2 are directed to methods of incorporating coupons with food items. In US Patent 7,264,582 B2, the coupon is inserted within crackers and in the instant application the coupon is inserted within a fortune cookie.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention of US Patent 7,264,582 B2 to insert coupons within a fortune cookie as US Patent 7,264,582 B2 teaches inserting coupons with crackers which are similar in nature to fortune cookies as both are single-serve food products, thereby allowing marketers to insert coupons with food items that consumers will view when waiting for their food or eating it at a restaurant.

See table below for direct comparison of claims.

| | |
|------------------------|-------------------------------|
| US PATENT 7,264,582 B2 | INSTANT APPLICATION 10/757152 |
|------------------------|-------------------------------|

| Claim 3 | Claim 1 |
|--|--|
| 3. A method for disseminating manufacturer coupons to a target consumer group, which method comprises: (a) packaging a product in a pouch container having associated therewith a manufacturer coupon pertaining to products or services other than said packaged product, wherein said packaged product is a single-serve food product, wherein said manufacturer coupon is redeemable by a consumer of said product and includes machine readable code associated therewith to facilitate automated processing of said coupon, and said manufacturer coupon is intended for a target consumer group; (b) packaging said packaged product in a shipping carton having a machine readable indicator assigned to said manufacturer coupon; (c) reading said indicator and in response thereto shipping said carton to consumer food service outlets associated with said target consumer group, whereby said packaged single-serve food product may be distributed to consumers thereby disseminating said manufacturer coupon, wherein said product is selected from the group consisting of single-serve sugar, sugar substitutes, salt, salt substitutes, pepper, ketchup, mayonnaise, mustard, sauces, and crackers . | 1. A method for disseminating advertising messages to consumers of fortune cookies, which method comprises: (a) providing an advertising insert having imprinted thereon an advertising message which may be viewed by a consumer; (b) producing a fortune cookie with said insert therein; (c) distributing said fortune cookie with said advertising insert to a consumer outlet; and (d) distributing said fortune cookie with said advertising insert to consumers associated with said consumer outlets, thereby disseminating said advertising message to said consumers (e) wherein said insert is selected from the group consisting of i) inserts comprising a plurality of superimposed, imprintable substrate sheets; ii) inserts comprising a plurality of imprintable substrate sheets, wherein said substrate sheets are affixed to each other; iii) inserts comprising an imprintable substrate sheet having a fold therein; iv) inserts comprising an imprintable substrate having imprinted thereon a manufacturer coupon redeemable by a consumer of said fortune cookie which includes machine readable code associated therewith to facilitate automated processing of said coupon; and v) inserts having an imprintable surface in excess of 3.5 square inches wherein said fortune cookie is produced from a circular blank approximately 3 inches in diameter. |

Table

Claim Rejections - 35 USC § 112

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6 **Claims 1-32 and 43-49 are rejected to under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Particularly in Claims 1 and 3, of which Claims 2, 4-32 and 43-49 depend, the language “may” is permissive language and fails to particularly point out and distinctly claim the subject

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matter which applicant regards as the invention. Applicant should avoid using permissive language as it does not further limit the claim.

Additionally in Claims 32 and 45, the claim language “UPC” and “UCC/EAN-128” appear to be acronyms, which are confusing and fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant should avoid using acronyms.

Claim Rejections - 35 USC § 103

7 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1-39 and 43-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over "A Year's Wait before Rendells enjoy their new house at Shore" by Michael Klein,**

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Philadelphia Inquirer, Philadelphia, Pa, Aug. 9, 2001. pg. D.1 (KLEIN) in view of Official Notice.

As per Claim 1: In general, KLEIN teaches: A consumer at a food service establishment [target consumer group] receiving a **fortune cookie** with a **coupon** inside [insert] which includes a discount **code** where the cookies have appeared in Philadelphia and Boston. These fortune cookies were provided by eBay-affiliated Half.com and Wonton Food Inc., a manufacturer of fortune cookies. The consumer reads the advertising found within the fortune cookie. KLEIN pg D.1

Although KLEIN teaches a consumer receiving a fortune cookie at a food service establishment [target consumer group] with a coupon inside [insert] which includes a discount code where the cookies have appeared in Philadelphia and Boston. These fortune cookies were provided by eBay-affiliated Half.com and Wonton Food Inc., a manufacturer of fortune cookies. The consumer reads the advertising found within the fortune cookie., **nevertheless, KLEIN does not expressly disclose** wherein said insert is selected from the group consisting of i) inserts comprising a plurality of superimposed, imprintable substrate sheets; ii) inserts comprising a plurality of imprintable substrate sheets, wherein said substrate sheets are affixed to each other; iii) inserts comprising an imprintable substrate sheet having a fold therein; iv) inserts comprising an imprintable substrate having imprinted thereon a manufacturer coupon redeemable by a consumer of said fortune cookie which includes machine readable code associated therewith to facilitate automated processing of said coupon; and v) inserts having an imprintable surface in

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excess of 3.5 square inches wherein said fortune cookie is produced from a circular blank approximately 3 inches in diameter..

HOWEVER, Official Notice is taken that it is old and well-known in the art of providing coupons to include a bar code or other machine readable code on it to facilitate its processing. It is further well known in the art to distribute fortune cookies with advertising to consumer outlets like Chinese restaurants to target customers of Chinese restaurants. It is further well known in the art to package products and to label shipping cartons with machine readable indicators, such as bar codes. It is further well known in the art for coupons to be included in coupon books. It is also well known in the art for coupons to be laminated, have folds, be affixed to each other, have adhesive, be detachable, and to be cut into different shapes and sizes. “Official Notice”

THEREFORE, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the teachings of **KLEIN** with **OFFICIAL NOTICE** so as to provide fortune cookies with varying types of coupons inside **thereby** allowing businesses to advertise effectively to their consumers through fortune cookies O/K, but too simplistic).

As per Claim 2: See the reasoning of the rejection of Claim 1 in addition: “...After the hot-and-sour soup and the General Tso chicken...” [where it is old and known in the art to provide fortune cookies at Chinese restaurants] **KLEIN D1**

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As per Claim 3: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to disseminate coupons to target consumer groups and sending coupons to a restaurant is targeting the consumers of the restaurant] **KLEIN D1**

As per Claim 4: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 5: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 6: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 7: See “...coupons...” [where it is old and known in the art to cut coupons from a larger sheet of paper] **KLEIN D1.**

As per Claim 8: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 9: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 10: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 11: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons that are detachable and laminated]
KLEIN D1.

As per Claim 12: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons that are detachable and laminated]
KLEIN D1.

As per Claim 13: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 14: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 15: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”
[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

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As per Claim 16: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 17: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to cut coupons from a larger sheet of paper] **KLEIN D1.**

As per Claim 18: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 19: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

As per Claim 20: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 21: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 22: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

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As per Claim 23: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 24: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to cut coupons from a larger sheet of paper] **KLEIN D1.**

As per Claim 25: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

As per Claim 26: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 27: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 28: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to cut coupons from a larger sheet of paper] **KLEIN D1.**

As per Claim 29: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

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As per Claim 30: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 31: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 32: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 33: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 34: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

As per Claim 35: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons in a coupon book] **KLEIN D1.**

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As per Claim 36: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 37: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 38: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

As per Claim 39: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to cut coupons from a larger sheet of paper] **KLEIN D1.**

As per Claim 43: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

As per Claim 44: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN D1**

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As per Claim 45: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with machine readable code] **KLEIN**

D1

As per Claim 46: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 47: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 48: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

As per Claim 49: See the reasoning of the rejection of Claim 1 in addition: “...coupons...”

[where it is old and known in the art to provide coupons with folds] **KLEIN D1.**

Conclusion

9 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

“Advertising in a tight spot-on fortune cookie slips”, Sunday, April 22, 2001, the Lubbock Avalanche-Journal provides for fortune cookies with coupons.

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“Half.com’s expansion is helping the US become a nation of online shopkeepers”

Internet Retailer; June 2001; by Andrea McKenna Findlay; provides for fortune cookies with coupons.

“It’s an Ad, Ad, Ad World: [third edition]; Marcella Bombardieri, Globe Staff, Boston Globe, Boston Mass. July 8, 2001. pg A.1.; provides for fortune cookies with coupons.

“What you didn’t learn in Marketing 101” Andy Cohen; Sales and Marketing Management; Aug 1999; 151,8 provides for fortune cookies with coupons.

“Wonton Food Inc.: Itty Bitty Advertising” by Adam Geller, the Associated Press, April 19, 2001 provides for fortune cookies with coupons.

<http://web.archive.org/web/20021206123443/www.gogorillamedia.com/html/gofortune.html> (published 12/06/2002) provides for fortune cookies with coupons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/
Examiner, Art Unit 3688
Tuesday, October 07, 2008

/Jean Janvier/
Primary Examiner, Art Unit 3688